

REMARKS

In the Office Action, the Examiner rejected claims 1-25. By this paper, claims 1, 9, 21, and 24 have been amended to clarify certain features to expedite allowance of the present application. No new matter has been added. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Interview Summary

In accordance with 37 C.F.R. § 1.133 and M.P.E.P. § 713.04, Applicants present the following summary of a telephonic interview between the Examiner and the Applicants' Attorney, David M. Hoffman, Reg. No. 54,174. The interview was conducted on November 16, 2005.

The interview was initiated by the Applicants' Attorney to discuss the pending Section 112 rejection and the Li reference (U.S. Patent No. 6,598,193) as it relates to the independent claims in the present application. After discussion of the Li reference and the pending claims, the Examiner agreed to withdraw the Section 112 rejection if Applicants amended claims 1, 9, 21, and 24 as indicated in the above Listing of Claims. Further, the Examiner indicated that presentation of the remarks below would likely overcome the Section 103 rejection based on the Li reference.

Rejection under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1, 9, 21, and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. As described above, the Examiner agreed during the Examiner's Interview conducted on November 16, 2005 to withdraw this rejection if Applicants amended claims 1, 9, 21, and 24 as indicated above. As such, in view of these amendments, Applicants respectfully request that the Examiner withdraw the pending Section 112 rejection against claims 1, 9, 21, and 24.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-25 under 35 U.S.C. § 103(a) as being unpatentable over Li et al. (U.S. Patent No. 6,598,193, hereafter referred to as "the Li reference"). Applicants respectfully traverse the Examiner's rejection.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In*

re Mills, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

Deficiencies of the Rejection

Turning now to the claims, Applicants respectfully assert that several features of independent claims 1, 9, 16, 21, and 24 are not disclosed by the cited references. For example, independent claims 1 and 9 recite a JTAG master that is “configured to be accessed remotely through the remote server management controller to provide *communication* between a remote computer and the at least one integrated circuit *via the JTAG interface.*” (Emphasis added). Independent claim 16 recites a method of communicating with an integrated circuit in a managed server comprising “receiving *data at the IOP* of the remote server management controller; transmitting *the data* from the IOP to the JTAG master; and transmitting *the data* from the JTAG master to the integrated circuit via the JTAG interface.” (Emphasis added). Independent claim 21 recites “connecting a computer to a remote server management controller” and “communicating by way of a JTAG master with an integrated circuit...via a JTAG interface.” Lastly, independent claim 24 recites a JTAG master “configured to be accessed remotely through the remote server management controller to provide *communication between a client computer and the integrated circuit via the JTAG interface.*” (Emphasis added).

The Examiner's rejection of independent claims 1, 9, 16, 21, and 24 is insufficient, because the Li reference does not teach or suggest the claim features recited above. The Li reference merely discloses a one-way, conventional file transfer between the management controller 102 and the remote systems 126 *via bus 118 and Ethernet controller 122*. *See* col. 4, lines 56-65; Fig. 4. Contrary to the Examiner's assertions, however, the mere fact that the transferred file happens to include JTAG-based test results does not make the file transfer either communication or communicating "via the JTAG interface," as recited in claims 1, 9, 21, and 24. In other words, transferring a file *created by and stored on* the management controller 102 via Ethernet simply *does not equate* to the claim features recited above. There is simply no disclosure in the Li reference of either communication or communicating "via the JTAG interface," as recited in claims 1, 9, 21, and 24. Moreover, the one-way file transfer of the Li reference does not equate to the features recited in claim 16, because the test results disclosed in the Li reference are being transferred in a different direction than "the data" recited in claim 16. *See id.* For at least the reasons set forth above, it is clear that the Li reference fails to teach or suggest the above-recited features of independent claims 1, 9, 16, 21, and 24. As such, Applicants respectfully assert that independent claims 1, 9, 16, 21, and 24 and the claims that depend thereon are patentable over the Li reference.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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